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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/622,439	08/17/00	MATSUMOTO	M 060438

HM12/0130

SUGHRUE MION ZINN
MACPEAK & SEAS
2100 PENNSYLVANIA AVENUE NW
WASHINGTON DC 20037

EXAMINER	
WEGERT, S	
ART UNIT	**PAPER NUMBER**
1647	5

DATE MAILED: 01/30/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	09/622,439	MATSUMOTO ET AL.	
	Examiner	Art Unit	
	Wegert	1647	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 August 2000* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claims *1-8* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
18) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other: .

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

A.

I. Claims 1 and 2, drawn to SREB receptor polypeptides.

II. Claims 3-6, drawn to a polynucleotide encoding an SREB receptor, an expression vector, a recombinant host cell, and a method of producing a peptide recombinantly.

III. Claim 7, drawn to a method for screening compounds which bind to the SREB receptor.

IV. Claim 8, drawn to an antibody against an SREB receptor.

B. The inventions are distinct, each from the other because of the following reasons:

The first claimed invention lacks a special technical feature because it fails to distinguish the claimed invention from the prior art (e.g., Wess, FASEB J, 1997). The prior art discloses a receptor polypeptide that meets the limitations of an "equivalent" receptor recited in the first claimed invention. Therefore, none of the other claimed inventions can share a special

technical feature with the first claimed invention. Furthermore, Inventions I and II are independent and distinct, each from each other, because they are products which possess characteristic differences in structure and function and each has an independent utility that is distinct for each invention which cannot be exchanged. The protein of Invention I can be made by another and materially different process such as by synthetic peptide synthesis or purification from the natural source. The polynucleotide of Invention II can be used to make a hybridization probe, or can be used in gene therapy as well as to produce the protein of Group I. Furthermore, the peptides of Invention I are related to the methods of invention II as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (M.P.E.P. § 806.05 (f)). In the instant case, the peptide may be isolated from its natural source or made by chemical synthesis.

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process (M.P.E.P. § 806.05 (h)). In the instant case the peptide of Invention I can be used for production of the antibodies of Invention IV.

The proteins of Invention I and the antibody of Invention IV are distinct inventions because they are products which possess characteristic differences in structure and function and each has an independent utility that is distinct for each invention which cannot be exchanged. The peptide of Invention I can be used for purposes other than to make an antibody of Group IV, such as a probe, or used therapeutically or diagnostically (e.g. in screening).

The products and methods of Invention II are distinct from the method of Invention III because the product of Invention II can be neither made by nor used in the method of Invention III, and because the methods require different process steps, reagents and parameters, and produce different products.

The products and methods of Invention II are distinct from Invention IV because they are products which possess characteristic differences in structure and function and each has an independent utility that is distinct for each invention which cannot be exchanged. Further the methods of Invention II can neither utilize the antibody of Invention IV nor be used to make such a product.

Inventions III and IV are independent and distinct, because the antibodies of Invention IV can be neither made by nor used in the methods of III.

Furthermore, restriction is required under 35 USC 121 and 372 as follows:

A. The Inventions named above as they pertain to Sequence ID No: 2

B. The Inventions named above as they pertain to Sequence ID No: 4

C. The Inventions named above as they pertain to Sequence ID No: 6

D. The Inventions named above as they pertain to Sequence ID No: 22

E. The Inventions named above as they pertain to Sequence ID No: 26

Each sequence (A-E) named above is independent and distinct, one from the other, because they have independent and distinct chemical structures. Their searches are non-overlapping, resulting in an undue search burden.

In order to be fully responsive, Applicant must pick one from Inventions I-IV, and one from Groups A-E.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, separate search requirements, and different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 C.F.R. 1.143)

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 C.F.R. 1.48(b) and by the fee required under 37 C.F.R. 1.17(i).

Advisory information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Wegert whose telephone number is (703) 308-9346. The

examiner can normally be reached Monday - Friday from 8:30 AM to 5:00 PM (Eastern Time).

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Gary Kunz, can be reached at (703) 308-4623.

Official papers filed by fax should be directed to (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Elizabeth C. Kemmerer

ELIZABETH KEMMERER
PRIMARY EXAMINER

SLW

Jan 17, 2001